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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,920	02/23/2004	Akihiro Daikoku	514242000300	7541
25227	7590	09/02/2005		
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			EXAMINER HARRINGTON, ALICIA M	
			ART UNIT 2873	PAPER NUMBER

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/782,920	Applicant(s) DAIKOKU, AKIHIRO	
	Examiner Alicia M. Harrington	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-13, 18 and 19 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-3,7,14-17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3,7 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakurai (US 6,089,761).

Regarding claim 1, Sakurai discloses an optical pickup lens comprising a lens (2) and a lens holder (1), wherein each of the lens and the lens holder has at least one mark (2b or 2a) in a direction rotation (around the circumference of the lens) based on an optical axis (see figure 1 or figure 2) of the lens as a center of rotation, wherein the mark of the lens is a line or a concave portion (2b-see col. 2, lines 35-67).

Regarding claim 2, Sakurai discloses wherein the mark of the lens holder (1b or 1a) is provided so as to oppose the mark of the lens (see figure 1 or figure 2).

Regarding claim 3, Sakurai discloses the mark of the lens and lens holder are provided at regular intervals, respectively (see figures 1 and 2).

Regarding claim 7, Sakurai discloses an optical pickup lens according to claim 1, wherein the lens (2) has a rounded edge (see figures 1 or 2), and the mark of the lens (2a or 2b) is provided on the round edge.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakurai (US 6,089,761).

Regarding claim 14 and 16, Sakurai discloses an optical pickup lens in a camera according to claim 1, wherein the lens (2) and the mark of the lens (2a or 2b) is integrally formed. However, Sakurai fails to specifically disclose the lens is plastic. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a plastic lens since they are lightweight and more heat resistant.

Regarding claim 15, Sakurai discloses wherein the mark of the lens is a concave (2b) portion formed on the lens. Sakurai fails to specifically disclose the process of forming of the mark as claimed. However, the manner or method in which a machine is to be utilized is not germane to the issue of patentability, *In re Casey*, 152 USPQ 235.

Regarding claim 17, Sakurai discloses the lens system for use in a camera. However, the intended use has been continuously held not to be germane to determining the patentability of the machine itself, In re Casey 152 USPQ 666.

Allowable Subject Matter

6. Claims 8-13,18,19 are allowed.

7. Claims 4,5,6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: Regarding claims 4 and 8, prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the dependent claims, in such manner that a rejection under 35 U.S.C 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in independent claims, which at least include an optical pick up lens according to claim 1, wherein one mark is provided on a position of a periphery of the lens, and at least eight marks are provided on positions the lens holder which are adjacent to the periphery of the lens.

Regarding claims 5 and 18, prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the dependent claims, in such manner that a rejection under 35 U.S.C 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in independent claims, which at least include an optical pickup lens according to claim 1, wherein one mark holder which

is provided on a position of the lens holder which is adjacent to a periphery of the lens, and at least eight marks are provided on positions of the periphery of the lens.

Regarding claims 6 and 19, prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the dependent claims, in such manner that a rejection under 35 U.S.C 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in independent claims, which at least include an optical pickup lens according to claim 1, wherein at least one of the marks of the lens is discriminated from the other marks of the lens.

Regarding claim 13, prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the dependent claims, in such manner that a rejection under 35 U.S.C 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in independent claims, which at least include an optical pickup lens according to claim 9, wherein angular intervals of the fittings portions of the lens are 45 degree.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ebert et al (US 6,441,975) discloses device for the low-deformation support of an optical element and method for the low-deformation support of the optical element.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Harrington whose telephone number is 571 272 2330. The examiner can normally be reached on Monday - Thursday 9:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571 272 2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AMH

Alicia M Harrington
Examiner
Art Unit 2873



Georgia Epps
Supervisory Patent Examiner
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